

PATENT

Case: 027698A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
Advait Badkar

GROUP ART UNIT: 1646

SERIAL NO: 10/583,923

CONFIRMATION NO: 4848

FILED: 12/13/2004

DATE: 012/14/2007

TITLE: STABLE GROWTH HORMONE LIQUID FORMULATION

RENEWED PETITION UNDER 37 CFR 1.47(a)

Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Hereby requested is a three month extension of time under 37 CFR 1.136(a).

BACKGROUND

In the above identified application a joint inventor Manpreet S. Wadhwa has refused to join in an application for patent.

On 20 June 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee.

On 26 January 2007, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating inter alia, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 14 May 2007, applicant petition under 37 CFR 1.47(a) along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor in

an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Manpreet Wadhwa alleging that Mr. Wadhwa refuses to sign the application.

On 17 July 2007, the Examiner dismissed the petition without prejudice alleging that the applicant had not provided factual proof that the non-signing inventor had refused to execute the application because the inventor's statement only refers to the Assignment and not the Declaration and Application Papers.

On 16 September 2007, the Examiner and the undersigned representative of the Applicant discussed in a telephone interview the Examiner's dismissal of the petition dated 17 July 2007 and the Applicant's petition date 14, May 2007. It was pointed out to the Examiner that the petition does state that the Declaration and Specification were sent to Mr. Wadhwa even though Mr. Wadhwa's statement, that was included with said petition, only refers to his refusal to sign the Assignment. The Examiner requested that the Applicant attempt to contact Mr. Wadhwa again to have him provide a statement that he had received the specification and the application papers and that he had refused to sign them.

DISCUSSION

As per the Examiner's request, the applicant's undersigned representative subsequently attempted to contact Mr. Wadhwa by email on two occasions notifying him of the Examiner's request and soliciting that he provide a further statement indicate that he had received the specification and application papers to sign and his refusal to sign applied to all of the documentation and not solely the Assignment. While a read receipt of the email was received Mr. Wadhwa has not responded to the applicant's request.

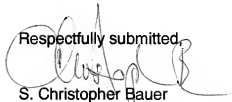
Absent a response from Mr. Wadhwa the applicant reasserts the claim of the petition of 14 May 2007 that the specification and application paperwork including both the Assignment and Declaration had been sent to Mr. Wadhwa for signature. In further support of this fact a copy of the letter of 23 March 2007 sent to Mr. Wadhwa and the receipt confirmation is included with the present petition. Applicant once more relies on Mr. Wadhwa's statement of 26 April 2007 submitted

with the previous petition as evidence of his refusal to sign. While the statement previously provided by Mr. Wadhwa only refers to the Assignment, his statement should be viewed as an all encompassing refusal to sign since he was provided the application and paperwork to sign including both the Assignment and Declaration.

CONCLUSION

Applicant submits that sufficient factual evidence has been provided to fulfill the requirements under 37 CFR § 1.47(a). Reconsideration and acceptance of the Applicant's petition is requested.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 16-1445.

Respectfully submitted,

S. Christopher Bauer
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Pharmacia Corporation of
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P. O. Box 1027
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S. Christopher Bauer
Pharmacia Corporation of Pfizer Inc
Global Patent Department
575 Maryville Centre Drive
St. Louis MO 63141

March 23, 2007

VIA CERTIFIED MAIL No. P 561 726 637
RETURN RECEIPT REQUESTED

Mr. Manpreet S. Wadhwa
238 Via Felicia
Thousand Oaks, CA 91320

RE: Pfizer Legal Documents for PC027698

Dear Mr. Wadhwa:

Pursuant to our previous letter and emails between November 2003 and January 2004, we are making a final attempt to obtain your signature on the enclosed Assignment and Joint Declaration and Power of Attorney for Pfizer's Case No. PC027698 (Stable Growth Hormone Liquid Formulation) in accordance with your contractual obligations under your employment contract.

Enclosed is an executed copy of your employment contract with Monsanto in which it states:

"I hereby assign to Monsanto, or its nominee, without further compensation, all of my right, title and interest in all such ideas, inventions or discoveries in all countries of the world." It further states, "However, should I render any of these services following termination of my employment, I shall be compensated at a rate per hour equal to the basic salary I received from Monsanto at the time of termination and shall be reimbursed for reasonable out-of-pocket expenses incurred in rendering the services."

Compensation is permitted, according to the above contractual agreement, but it is not at a consultant's rate; it is at a rate equal to your former basic salary.

Should you persist in refusing to sign, we will file the Assignment and Declaration without your signature under the provisions of 35 U.S.C. § 116:

"If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined."

Mr. Manpreet S. Wadhwa
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and 35 U.S.C. § 118:

"Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the inventor or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes."

We will indicate to the USPTO your obligation to sign under the provisions of your employment contract, and your reason for not signing is that you wanted financial compensation exceeding that which is provided for in your employment contract. I would also like to remind you that your breach of contract will be in the public record.

Also enclosed is a copy of the application as filed should you wish to review it at this time.

Please sign these documents, have the Assignment notarized, and return them to us by April 9, 2007, in the enclosed self-addressed envelope so that they can be filed with the U. S. Patent & Trademark Office.

Please invoice us for any reasonable time and expense that you may incur.

If you have any questions regarding this letter or the attached documents, please contact me.

Sincerely,



S. Christopher Bauer
Endocrine Care Site Head St. Louis
TEL: 314-274-6257
FAX: 314-274-9095
EMAIL: s.christopher.bauer@pfizer.com


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